

## **REMARKS**

Applicant respectfully requests reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks.

Claims 1-17 and 21-23 are pending in the application, with claims 1, 13, and 21 being independent. Claims 18-20 are canceled herein without prejudice to or disclaimer of the subject matter recited therein. Claims 1, 8, 9, and 13 are amended. Claims 21-23 are newly added. Support the claim amendments and additions can be found in the original specification as filed at least at paragraphs [0015], [0017], and [0022], and FIGS. 1-5. No new matter has been added.

### **Information Disclosure Statement**

The Office Action indicates that the two U.S. patent applications listed on the March 4, 2004 Information Disclosure Statement (IDS) have been “lined through ... since a US patent application is not prior art.” Without making any representation as to the materiality of the cited applications relative to the subject application, Applicant notes that pending U.S. applications may, in some circumstances, qualify as prior art under one or more of 35 U.S.C. §§ 101 (double patenting) or 102(c), or under the judicially created doctrine of obviousness-type double patenting. Accordingly, Applicant requests that the PTO-1449 form from the March 4, 2004 IDS be initialed and returned, indicating that the listed U.S. applications have been considered.

### **§ 112 Rejection**

Claims 8 and 9 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because “[t]hese claims claim a line which is not contemplated by the preamble of

claim 1.” Claims 8 and 9 are amended herein to clarify that the line is not being positively recited in claims 8 and 9, thereby obviating the § 112 rejection of these claims.

### **§ 102 Rejection**

**Claims 1, 5, 7, 8, and 10-16 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,171,123 (Woelkers).** This rejection is respectfully traversed. Nevertheless, without conceding the propriety of the rejection, independent claims 1 and 13 are amended.

**Independent claim 1** is directed to an apparatus for pulling line through a raceway, and as presently presented recites, among other things, “a body having a plurality of mounting apertures therethrough lying in a common plane, and a plurality of elongated recesses, one of the elongated recesses being positioned between each two consecutive mounting apertures along the length of the body.”

Woelkers discloses a conductor-pulling device comprising “an elongated strip of material having a plurality of spaced openings 24 therealong for independently receiving respective conductors” (col. 3, lines 28-31). According to Woelkers, the pulling member 14 “has a flat planer configuration” and “is made of flexible material in order to allow the strip 14 to be pulled around curves or bends in the conduit 16” (col. 4, lines 9-12).

However, there is no disclosure or suggestion in Woelkers of “a body having ... a plurality of elongated recesses, one of the elongated recesses being positioned between each two consecutive mounting apertures along the length of the body,” as presently recited in independent claim 1. Accordingly, claim 1 is allowable over Woelkers.

**Independent claim 13** is directed to an apparatus for pulling line through a raceway, and as presently presented recites, among other things, “mounting means having multiple securing means ... [and] crenellated recesses disposed between the multiple mounting means for providing an area around which lines can be secured to the mounting means.”

As discussed above, Woelkers discloses a conductor pulling device comprising an elongated strip of material having a plurality of spaced openings. However, Woelkers fails to disclose or suggest “mounting means having multiple securing means ... [and] crenellated recesses disposed between the multiple mounting means for providing an area around which lines can be secured to the mounting means,” as presently recited in independent claim 13. Accordingly, claim 13 is allowable over Woelkers.

**Dependent claims 5, 7, 8, 10-12, and 14-16** depend from one of independent claims 1 and 13, and each is allowable by virtue of its dependency from the respective base claim, as well as for the additional features that it recites.

### **§ 103 Rejections**

**Claims 2, 6, and 17 were rejected under 35 U.S.C. § 103(a) as being obvious over Woelkers in view of U.S. Patent No. 4,101,114 (Martin et al).** This rejection is respectfully traversed.

Dependent claims 2, 6, and 17 depend from one of independent claims 1 and 13, and each, therefore, includes all of the features of its respective base claim.

Martin et al. was cited for its alleged teaching that “a line pulling device may have releasable hook and loop attachment means between the body and the fish tape.” Assuming for the sake of argument that the documents can even be combined as suggested in the Office

Action, Martin et al. still fails to remedy the deficiencies in Woelkers discussed above with respect to independent claims 1 and 13. In particular, Martin et al. fails to disclose or suggest “a body having ... a plurality of elongated recesses, one of the elongated recesses being positioned between each two consecutive mounting apertures along the length of the body” or “mounting means having ... crenellated recesses disposed between the multiple mounting means for providing an area around which lines can be secured to the mounting means,” as presently recited in independent claims 1 and 13, respectively.

Accordingly, claims 2, 6, and 17 are allowable by virtue of their dependency from independent claims 1 and 13, respectively, as well as for the additional features that they recite.

For example, **dependent claim 6** recites that “the attachment member comprises a hook having a loop attached to the end of the body.” The Office Action asserts on page 3 that this feature is taught by Martin et al. However, the Office Action fails to point to any portion of Martin et al. for these alleged teachings. Nor does Martin et al. appear to disclose any element that could be said to correspond to the claimed “attachment member compris[ing] a hook having a loop attached to the end of the body” of claim 6. Accordingly, claim 6 is allowable for at least these additional reasons.

**Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being obvious over Woelkers in view of U.S. Patent No. 6,098,250 (Katz).** This rejection is respectfully traversed.

Dependent claims 3 and 4 depend from independent claim 1 and, therefore, include all of the features of that claim.

Katz was cited for its alleged teaching that “the body may have complementary recesses along the body and rounded apertures.” Assuming for the sake of argument that the documents

can even be combined as suggested in the Office Action, Katz still fails to remedy the deficiencies in Woelkers discussed above with respect to independent claim 1. Katz discloses a “fastening device [or belt] comprising a strip of colored plastic molded in a desired shape” and that “[a]t both ends of the strip are a plurality of loops [which] may be directly attached to the object to be secured” (Abstract). However, Katz fails to disclose or suggest “a body having ... a plurality of elongated recesses, one of the elongated recesses being positioned between each two consecutive mounting apertures along the length of the body,” as presently recited in independent claim 1. Accordingly, claims 3 and 4 are allowable by virtue of their dependency from independent claim 1, as well as for the additional features that they recite.

In addition, one of ordinary skill in the art would not have been motivated to modify the line puller of Woelkers in view of the teachings of Katz, because Katz is non-analogous art. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” MPEP 2141.01(a) (citing *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). Here, Katz is neither in the field of Applicant’s endeavor (e.g., line pullers), nor pertinent to the particular problem with which the inventor was concerned (e.g., securing one or more lines to apertures of a line puller). Thus, one of ordinary skill in the art would not have been motivated to look to Katz to modify the line puller of Woelkers. Claims 3 and 4 are allowable for at least this additional reason.

**Claim 9 was rejected under 35 U.S.C. § 103(a) as being obvious over Woelkers in view of U.S. Patent No. 6,193,217 B1 (Zimmer).** This rejection is respectfully traversed.

Dependent claim 9 depends from independent claim 1 and, therefore, includes all of the features of that claim.

Zimmer was cited for its alleged teaching that “a line may be releasably secured to the aperture by tape.” Assuming for the sake of argument that the documents can even be combined as suggested in the Office Action, Zimmer still fails to remedy the deficiencies in Woelkers discussed above with respect to independent claim 1. In particular, Zimmer fails to disclose or suggest “a body having ... a plurality of elongated recesses, one of the elongated recesses being positioned between each two consecutive mounting apertures along the length of the body,” as presently recited in independent claim 1. Accordingly, claim 9 is allowable by virtue of its dependency from independent claim 1, as well as for the additional features that it recites.

### **New Claims**

New claims 21-23 recite additional features not disclosed or suggested by the cited documents. In particular, **independent claim 21** recites:

21. An apparatus for pulling line through a raceway, the apparatus comprising:
- an undulated body having a plurality of expanded mounting apertures along the length of the body for receiving line, and a plurality of elongated recesses providing areas for securing the line to the body, one of the elongated recesses being positioned between each two consecutive mounting apertures along the length of the body; and
  - an attachment member releasably coupled to the undulated body, the attachment member comprising a loop at one end thereof releasably coupling the attachment member to the undulated body, and a hook disposed at an opposed end thereof for releasably coupling the attachment member to a fish tape.

None of the cited documents disclose “an undulated body having a plurality of expanded mounting apertures along the length of the body for receiving line, and a plurality of elongated

recesses providing areas for securing the line to the body, one of the elongated recesses being positioned between each two consecutive mounting apertures along the length of the body” or “an attachment member ... comprising a loop at one end thereof releasably coupling the attachment member to the undulated body, and a hook disposed at an opposed end thereof for releasably coupling the attachment member to a fish tape,” as recited in new claim 21.

Accordingly, new claim 21 is allowable over the cited documents.

New claims 22 and 23 depend from independent claim 21, and each is allowable by virtue of its dependency from that claim, as well as for the additional features that it recites.

### **Conclusion**

Favorable consideration and an early notice of allowance are respectfully requested. If any issue remains unresolved that would prevent allowance of this case, **the Examiner is requested to contact the undersigned attorney to resolve the issue.**

### **Fees**

No fees are believed to be due in connection with this paper; however, the Commissioner is hereby authorized to charge any fees due, and to credit any overpayments, to Deposit Account Number 12-0769.

Respectfully submitted,

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